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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/631,910	07/31/2003	Hiroyuki Yanagisawa	KON-1807	9630
20311	7590	03/20/2007	EXAMINER	
LUCAS & MERCANTI, LLP 475 PARK AVENUE SOUTH 15TH FLOOR NEW YORK, NY 10016			CHEA, THORL	
		ART UNIT	PAPER NUMBER	
				1752
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE		DELIVERY MODE	
3 MONTHS	03/20/2007		PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/631,910	YANAGISAWA, HIROYUKI
	<b>Examiner</b> Thorl Chea	<b>Art Unit</b> 1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 16 January 2007.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-3,7-9 and 14-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3,7-9 and 14-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

1. This office action is responsive to the communication on January 16, 2006; claims 1-3, 7-9, 14-20 are pending in this instant application; claims 4-6, 10-13 have been canceled.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 7-9, 14-20 are rejected under 35 U.S.C. 103(a) as obvious over either EP 1278101 (EP'101), Nishijima et al (US Patent No. 6,699,649) or Patent Specification 1543266 (PS'266) in view of Yoshioka et al (US Patent No. 6,413,712).

EP'101, Nishijima et al and PS'266 each discloses a photothermographic material containing a reducing agent having formula with the scope of A-1 claimed, except the compound of formula A-4. See EP'101, Nishijima et al and PS'266 on page 15, formula (I) wherein R3 represent an aryl group ( a phenyl group or naphthyl group). Yoshioka et al disclose a compound of formula A-4 claimed in the present claimed which when used in combination with a bisphenols compound provide a photothermographic material affording a sufficient image density under general image producing conditions and capable of suppressing the time-dependent tint of the white background after development processing. See column 2, lines 12-18 and formula (II). It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use the phenol compound taught in Yoshioka et al in the material of either EP'101, Nishijima et al or PS'266 with an expectation of achieving a photothermographic material

affording a sufficient image density under general image producing conditions and capable of suppressing the time-dependent tint of the white background after development processing, and thereby provide a material as claimed. The regression value as claimed is considered as inherent to the combination of reducing agent stem obtained by the combination of those taught in the applied prior art of record after the image forming process since the combination of the bisphenols reducing agent and the phenol compound taught in Yoshioka et al provide a sufficient density and suppressing the time depend tint of the white back ground after processing, and the regression value present in the claimed invention is related to the control of color tone of the material after processing.

4. Claims 1-12, 14-20 are rejected under 35 U.S.C. 103(a) as obvious over the combination of Oya et al (US Patent No. 6,376,166) and Yoshioka et al (US Patent No. 6,413,712).  
Oya discloses photothermographic material having a reducing agent within the scope of the claimed invention. See compound of formula (I) in the abstract and the definition of V<sup>9</sup> in column 7, lines 55-60 which an aryl group such as phenyl, p-methylphenyl and naphthyl, except the compound of formula (A-4). Yoshioka et al disclose a compound of formula A-4 claimed in the present claimed which when used in combination with a bisphenols compound provide a photothermographic material affording a sufficient image density under general image producing conditions and capable of suppressing the time-dependent tint of the white background after development processing. See column 2, lines 12-18 and formula (II). It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use the phenol compound taught in Yoshioka et al in the material of Oya et al with an expectation of achieving a photothermographic material affording a sufficient image density under general

image producing conditions and capable of suppressing the time-dependent tint of the white background after development processing, and thereby provide a material as claimed. The regression value as claimed is considered as inherent to the combination of reducing agent obtained by the combination of those taught in the applied prior art of record after the image forming process since the combination of the bisphenols reducing agent and the phenol compound taught in Yoshioka et al provide a sufficient density and suppressing the time depend tint of the white back ground after processing, and the regression value present in the claimed invention is related to the control of color tone of the material after processing.

***Response to Arguments***

Applicant's arguments filed January January 9, 2007 have been fully considered but they are not persuasive of the reason set forth in the Office Action on October 10, 2006 and the Declaration under 37 CFR 1.132 on January 9, 2007 fails to overcome the prima facie case of obviousness rejection. First, the Declaration has a little probative value. The Declaration fail to establish that he is the one of ordinary skill in the art, and fails to state that he found that the results that presented in the Declaration unexpected or surprising. On page 6, paragraph 11, he states that : “I believe that the results shown in the attached Table are surprising and unexpected to those of skill in the art; because the cited references do not teach or suggest that a superior image is produced by employing a combination of a reducing agent of Formula (A-I), a reducing agent of Formula (A-3) and a compound of Formula (A-4)”. The statement of the unexpected results are based on the assumption that the results would have been found unexpected by the worker of ordinary skill in the art when they see the results. Therefore, no unexpected results to the worker of ordinary skill in the art has been established. Second, the inventive samples B, L contains

three type of reducing agents A-1, A-3 and A-4, whereas the comparative samples contains either A-1; A-2 and A-4; A-1 with A-4 ; or A-1 and A-3. Therefore, they samples would show different results due to their differences in composition of the reducing agent. Third, the Declaration fails to establish the relationship between the coefficient of determination  $R^2$  and the scope the combination of the compound A-1, A-3 and A-4. The scope of the compound of formulae A-1, A-3 and A-4 encompasses the scope beyond the scope of the specific compound I-24, I-3 and II-3 used in the inventive samples. It is unclear whether the coefficient of determination of  $R^2$  of the regression line from 0.998 to 1.000 control the quality of the photothermographic material or the combination of the compounds of formula A-1, A-3 and A-4. The  $R^2$  value depends not only with the compound with the process associated with the formation of an image. Fourth, it is unclear as how the “anatomical and physical results” used to determine the quality of the image, i.e., how these values translate into the Dmin, Dmax or the contrast of the image. It appears that these anatomical and physical results were determined by the observation of 7 observers (see p. 207 of the specification). Therefore, the results are relative to the eyes of the observers, and cannot be used to determine the unexpected results.

### *Conclusion*

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (571) 272-1328. The examiner can normally be reached on 9 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tchea  
2007-03-07



Thorl Chea  
Primary Examiner  
Art Unit 1752